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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,649	12/17/2001	Francis D. Palazzo	SEDN/4665/5	1815

56015 7590 12/09/2008
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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2421

MAIL DATE	DELIVERY MODE
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12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/022,649	Applicant(s) PALAZZO ET AL.	
	Examiner Jason P. Salce	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 09/04/2008 have been fully considered but they are not fully persuasive.

Applicant further argues that the specification provides support for the claimed limitations. Applicant further notes that "advertisements" and "promotional programming" are being introduced as being interchangeably used with respect to Figure 6. The examiner disagrees and notes that the word "or" clearly distinguishes between two separate entities, an advertisement "or" promotional programming. Pages 17-18 further states that when viewing a "promotional", an "advertisement" can be set for recording, again distinguishing between the two entities (the promotional programming and the advertisement). Figures 5-6 further show examples of recording an advertisement to memory. Figure 5 further supports that an advertisement and promotional programming are separate entities and that when a promotional is selected an advertisement can be selected for recording. Figure 6 again show recording an advertisement while viewing a promotional and because the specification has separately defined the two entities, the examiner cannot assume that these terms can be used interchangeably based on the definition of these entities in the specification. For example, a promotional can be an item in the programming event (television show) being viewed in Figure 6 and if the viewer is interested in the promotional, the user can record an advertisement related to the promotional being viewed.

Applicant further argues that an additional embodiment introduced on Page 3, Lines 16-18 further teaches an option to record an advertisement currently being displayed (**see further arguments below**).

The examiner further notes that even if these terms were interpreted interchangeably, the specification still fails to positively recite storing an interactive advertisement during presentation of the interactive advertisement. Further, if both terms were to be interpreted as being interchangeable, as suggested by Applicant, then each term could be broadly interpreted as different pieces of data or specifically interpreted as equivalent pieces of data. In either case, the specification is written in a way where either interpretation can be applied. Therefore, by Applicant stating that these terms can be used interchangeably, no further clarification has been provided because the interchangeable terms, as suggested by the Applicant, can be interpreted as different or similar pieces of data.

Applicant further argues that earlier portions of the specification teach that EPG actions are available from within the broadcast advertisement. Applicant is further assuming the tense of "the broadcast advertisement". The examiner does not understand how the tense of the term "the broadcast advertisement" can be determined from the present description in Applicant's specification. The broadcast advertisement can still be an advertisement displayed to the viewer at any point in time and not necessarily as the viewer is actually viewing the advertisement, but instead viewing a promotional, as taught by Figures 5-6. Further, noting that EPG actions are available

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from within the broadcast advertisement only states that a viewer can perform EPG options by accessing the metadata instructions received within the advertisement.

Nowhere does the specification teach that while viewing an advertisement, a viewer can record the advertisement while currently viewing the advertisement.

Applicant further cites Page 15, Lines 5-6 and states that “the check is performed when an advertisement is selected that is being broadcast”. The Examiner agrees that a broadcast advertisement currently displayed can be selected during presentation of the broadcast advertisement, however, this cited portion fails to teach that the advertisement is actually recorded/stored during presentation of the interactive advertisement or at a future time.

The Examiner recognizes that Page 16 teaches that a storage EPG action parameter can be passed to a storage device to store the advertisement in response to the check performed on Page 15, Lines 5-6, however, this portion of the specification still fails to specifically state whether the advertisement is stored during presentation of the advertisement or at a later time when the advertisement is replayed.

Applicant further argues that Pages 10 and 11 support the claimed limitations. Applicant states, “One of the EPG actions available from within the advertisement may be storing the advertisement (**i.e. the advertisement being presented**)”. The examiner notes that this portion of the specification fails to teach the claimed limitations. The specification does not clearly distinguish between an advertisement currently being displayed or displayed at a future time.

Applicant further argues that Figure 6 further provides support for Pages 10 and 11 of the specification, however Figure 6 is explained in detail on Pages 17 and 18 of Applicant's specification. As stated on Pages 17-18, the advertisement that is to be recorded is clearly distinguished from the "promotional" being displayed. This is further supported by Figure 5 of the specification. Therefore, Applicant's own specification actually supports that the advertisement being recorded is separate from the "promotional" advertisement being displayed. Therefore, Applicant's specification does not clearly disclose recording an advertisement during presentation of the advertisement.

The Examiner further notes that the claim is written in such a way where an alternative interpretation exists. The claim recites, "***presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing, during presentation of the interactive advertisement***". The Examiner notes that that the limitation, "***during presentation of the interactive advertisement***" can relate to the selectable option or the storage of the interactive advertisement (**Applicant's interpretation**). Therefore, since the claim limitations can be interpreted as the selectable option, which is intended to be used for storage of an interactive advertisement while displaying the interactive advertisement, a new grounds of rejection is presented below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to independent claims 16-32, the claims recite the limitations, “presenting the interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement on a user-defined storage device for future viewing, **during presentation of the interactive advertisement**”. The examiner notes that feature is not taught by the specification of the instant application.

Note Figure 6, Page 3, Lines 9-15 and Pages 17-18 where the interactive advertisement is only recorded if the interactive advertisement is not presently playing. For example, if the interactive advertisement is currently playing, the channel will be force tuned to the channel playing the interactive advertisement (not recorded), therefore the claim could never be supported by the specification where an interactive advertisement is recorded while it is currently playing. Specifically note Page 3, Lines

9-15, where the specification specifically states, “***The video window contains promotional programming such as an advertisement for a sports event or movie, whether presently playing or scheduled to be broadcast at a future time/or date. By selecting the video window, the viewer may view expanded information about the event and, if desired, be AUTOMATICALLY OR FORCE TUNED TO THE PROGRAM BEING PROMOTED***”. The specification separately teaches, “***If the event being promoted is to be aired IN THE FUTURE, THE VIEWER IS DIRECTED TO DIALOGS FOR SETTING A PROGRAM REMINDER OR TO PROGRAM A VIDEO RECORDING DEVICE***”. Therefore, the specification teaches away from what is claimed. The only time a program is reserved for a recording is when it is to be broadcast in the future, therefore an actual recording cannot be performed during presentation of the interactive advertisement. Also note Figure 6 and Pages 17-18 where the viewer is viewing a “**promotional**” and further access the “**promotional**” to record an “**advertisement**”, clearly the specification distinguishes between what is viewed and what is being recorded in addition to the specification to specifically teaching recording while the advertisement is currently being presented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16-21 and 24-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885) in view of Alexander et al. (U.S. Patent No. 6,177,931).

Referring to claim 16, Fries discloses providing access to EPG features from within broadcast advertisements (**see Figure 6 for accessing program listings (one broadcast advertisement)**) from within broadcast advertisements (**the page options presented in Figure 6**)).

Fries also discloses receiving the broadcast advertisement comprising audio, video and promotional metadata over a broadcast distribution network (**see Column 3, Lines 24-28 for receiving audio and video over a broadcast distribution network, Column 3, Lines 66-67 and Column 4, Lines 1-3 for providing information pages (metadata), and Column 6, Lines 52-55 to teach that the information pages can be sent from advertisers, therefore teaching that the metadata is promotional metadata**), the promotional metadata including a plurality of data items (**see Figure 6 for the promotional page (containing advertisements) consisting of a plurality of data items**), the data items including a promotion type (**“Market Report” option in Figure 6 or the page accessed in Figure 8**) and an EPG feature (**“Television Listings” option in Figure 6**), the promotion type including a purchasable event (**see “Purchase Now” option in Figure 8**) and an interactive advertisement (**see “Selection Chart” option in Figure 8**).

Fries also discloses displaying the interactive advertisement (**see again Figure 8 for the “Selection Chart”**), but fails to teach the selectable option to store the interactive advertisement for future viewing on a user-defined storage device.

Alexander discloses presenting an interactive advertisement, the interactive advertisement including a selectable option for the user to store the interactive advertisement for future viewing on a user-defined storage device, during the presentation of the interactive advertisement (**see Column 4, Lines 28-43 and Column 19, Line 46 through Column 20, Line 12 for presenting an interactive advertisement, wherein the interactive advertisement includes a selectable option used to record the interactive advertisement (wherein the interactive advertisement includes the selectable option and the actual ad that is recorded), wherein the selectable option is presented during presentation of the interactive advertisement**). Further note Column 5, Lines 7-8 for Alexander teaching that a virtual channel ad may promote a current television program.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the EPG, as taught by Fries, using the recordable interactive advertisement feature, as taught by Alexander, for the purpose of providing improved opportunities for the commercial advertiser to reach the viewer (**see Column 2, Lines 13-14 of Alexander**).

Referring to claim 17, Fries also discloses presenting a broadcast advertisement based on the data items (**see Figure 6 for displaying broadcast advertisements**

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available for selection), the broadcast advertisement including the EPG feature (again note that the broadcast advertisements in Figure 6 contain the broadcast advertisement for selecting television listings and therefore a broadcast advertisement in the list of broadcast advertisements includes an EPG feature).

Fries also disclose executing the EPG feature when selected from within the broadcast advertisement by the user (**see Column 7, Lines 17-21**).

Fries also discloses that the EPG feature accesses on-online content (**see Column 4, Lines 1-16**).

Fries also discloses collecting payment information, if the promotion type is the purchasable event (**see Column 13, Line 55 through Column 14, Line 57 and Figure 7**). *Further note Column 14, Line 48 for collecting a payment.*

Referring to claim 18, Fries discloses that a plurality of promotions is interspersed among the broadcast audio and video content (**see Column 5, Lines 37-50 and Lines 60-67 for extracting audio, video and data packets interspersed within a 6 megahertz television channel, according to their PIDs**).

Referring to claim 19, Fries discloses presenting the promotion within an EPG, when the promotion type is the interactive advertisement (**see Figures 6 and 8 for presenting a promotion “MARKET REPORT” within an EPG 108, where the promotion is the interactive advertisement**).

Referring to claim 20, Fries discloses that the data items include a web action **(see anchor focus area action in the table under Column 8)** and a web address **(see Column 22, Line 67 through Column 23, Line 3 for the data containing information for linking to another page).**

Fries also discloses receiving a selection of the web action and providing access to a web page associated with the web address **(see Figure 6 and Column 6, Line 66 through Column 7, Line 53 for displaying a menu web page and selecting a link from the page and accessing other web pages from the current page).**

Referring to claim 21, Alexander discloses the use of a PIP window to display advertisements **(see Figure 1)**, therefore, the web page advertisements presented by Fries could be modified to display the web page advertisements in a PIP window.

Referring to claim 24, Fries discloses storing a plurality of promotions **(see browser 62 in Figure 3 and Column 6, Lines 35-42).**

Fries also discloses presenting the stored promotions **(see Figure 6).**

Referring to claim 25, Fries discloses that the data items are selected from an EPG action **(see Figure 6 and Column 7, Lines 40-47 for the ESPN pages containing EPG actions).**

Referring to claim 26, Fries discloses that the EPG action is selected from a pay-per-view purchase (**see Column 13, Lines 47-64**).

Referring to claim 27, Fries discloses a set top terminal (**see Figure 3**) for providing access to interactive features of EPGs from within broadcast advertisements (**see Figures 6-8**).

Fries also discloses a network interface to receive broadcast audio and video content (**see tuners 70 and 71 in Figure 3**) along with at least one promotional metadata file associated with the broadcast audio and video content from a distribution network (**see Figure 7**).

Fries also discloses a promotional metadata storage to store the promotional metadata file (**see Column 14, Lines 60-65 for storing the promotional metadata in NVRAM 86**), the promotional metadata file including a plurality of data items (**see Column 14, Lines 60-65 for the promotional metadata file including an ACTION URL and query string**), the data items including a promotion type and an EPG action (**see Column 14, Lines 60-65 for the data including an ACTION URL and METHOD and further note Column 13, Lines 47-57 for the data further containing a purchase now option**), the promotion type including an interactive advertisement (**see again Column 13, Lines 47-57 and Column 14, Lines 47-65**).

Fries also discloses a presentation component to provide a presentation and a plurality of navigation tools (**see Figure 3 for overlay mixer 98 to display both a presentation and navigation tools in Figure 8 which teaches presenting**

navigation tools), the presentation including the broadcast audio and video content (see video and audio decoder 52 and 92 in Figure 3), at least one EPG (see Figure 6 for the television listings option 110₅), and at least one promotion (see Figure 8 for promotion items for purchase), the promotion being based on at least a portion of the data items (see Figure 8 for the promotion being based on the data items presented on the page).

Fries also discloses a display interface to present the presentation and navigation tools on a display device (see element 30 in Figure 3), wherein the navigation tools provide interaction with the EPG action within the promotion (see again Figure 8).

Fries also discloses displaying the interactive advertisement (see again Figure 8 for the “Selection Chart”), but fails to teach the selectable option to store the interactive advertisement for future viewing on a user-defined storage device.

Alexander discloses a user-defined storage device for storing an interactive advertisement when the user selects an option to store the interactive advertisement for future viewing, during the presentation of the interactive advertisement (see Column 4, Lines 28-43 and Column 19, Line 46 through Column 20, Line 12 for presenting an interactive advertisement, wherein the interactive advertisement includes a selectable option used to record the interactive advertisement (*wherein the interactive advertisement includes the selectable option and the actual ad that is recorded*), wherein the selectable option is presented during presentation of the

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interactive advertisement). Further note Column 5, Lines 7-8 for Alexander teaching that a virtual channel ad may promote a **current television program**.

Alexander also discloses a digital video recorder for future viewing of the stored interactive advertisement by the user (**see Column 12, Lines 10-43 for recording programs on a digital video disc, thereby teaching a digital video recorder**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the EPG, as taught by Fries, using the recordable interactive advertisement feature, as taught by Alexander, for the purpose of providing improved opportunities for the commercial advertiser to reach the viewer (**see Column 2, Lines 13-14 of Alexander**).

Referring to claims 28-32, see the rejection of claims 17-19 and 25-26, respectively.

3. Claims 22-23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (U.S. Patent No. 6,317,885) in view of Alexander et al. (U.S. Patent No. 6,177,931) in further view of Lawler et al. (U.S. Patent No. 5,699,107) in further view of Matthews, III et al. (U.S. Patent No. 6,025,837).

Referring to claim 22, Fries and Alexander disclose all of the limitations in claim 17, as well as Fries disclosing displaying data items on a television display (**see Figures 6 and 8**), but fails to teach the additional limitations.

Lawler discloses displaying data items on a television display, the data items including a show date, show time and tune action (**see Figure 3 and note that the tune action is the channel number the viewer must tune to or the cell that can be selected by the user**).

Lawler also discloses determining whether the promotion is for an event that is presently playing using the data items (**see step 224 in Figure 4A**), the data items including a show date and show time (**see Figure 3**).

Lawler also discloses setting a reminder, when a program reminder is selected and the event is not presently playing (**see step 236 in Figure 4A and step 314 in Figure 7 and Figure 8**).

Lawler also discloses tuning the event, when the event is presently playing (**see Column 10, Lines 10-14**).

At the time the invention was made, it would have been obvious to modify the system of Fries and Alexander, using the reminder system of Lawler, for the purpose of allowing a user to quickly and easily find and select desired future programs for reminding (**see Column 2, Lines 8-10 of Lawler**).

Fries and Lawler fail to disclose tuning the event, when the event is presently playing and the program reminder is not selected.

Matthews discloses setting a reminder and automatically tuning to the channel after the reminder has been displayed (**see Column 12, Lines 31-36**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the reminder system of Fries, Alexander and Lawler,

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using the automatic tuning reminder system, as taught by Matthews, for the purpose of providing a better way of integrating supplemental content, be it on the Internet or elsewhere, with conventional TV and movie programs (**see Column 4, Lines 22-24 of Matthews**).

Claim 23 corresponds to claim 22, Lawler further discloses setting a recording device, when the event is not presently playing and the program reminder is not selected (**see Figure 10**).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Jason P Salce/
Primary Examiner, Art Unit 2421

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Art Unit 2421

December 4, 2008